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### REMARKS

1. Amendments to Claims

Claim 1 has been amended to include the limitations of claim 7, namely that presentation of the banner advertisement is carried out by a proxy server addressed by client software on the user's computing device, as illustrated in Fig. 4 and described in lines 1-24 on page 20 of the original specification, and in particular lines 20-24 which describe tasks performed by the "client software," including "diversion of the initial service call to the advertisement server 3 is the advertisement server is a proxy server, . . .".

Claim 15, which is directed to the feature wherein the blocking feature may be by-passed if the user is found to have a subscription to the website, has been re-written in independent form to include the limitations of claims 1 and 14, from which it originally depended.

Claim 21 has been amended including the limitations of claim 25, directed to a proxy server.

Finally, claim 32 has been re-written in independent form to include the limitations of claims 31 and 21, and in addition to recite by-pass of the blocking effect if the user has a subscription to the requested website.

It is respectfully noted that these amendments have been made not only to overcome the outstanding rejections, but also to overcome the rejection based on U.S. Patent 6,636,247 (Hamzy). Although the applicant believes that the Hamzy patent was removed as a reference by a declaration under 37 CFR 1.132, the Examiner threatens to re-apply the rejection based on the Hamzy reference if the currently outstanding rejections are overcome. Therefore, the amendments seek to distinguish the Hamzy reference in the interest of expediting allowance of the application.

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2. Rejection of Claims 1, 2, 5, 6, 8-15, 19-24, 26-32, 35-39, and 42-49 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier), 6,339,761 (Cottingham), and 5,838,314 (Neel)

This rejection, at least with respect to amended claims 1 and 21, has been rendered moot by the addition to claims 1 and 21 of the limitations of independent claims 1 and 25.

In addition, it is respectfully noted that independent claim 33 is not included in this rejection.

However, the rejection is respectfully traversed with respect to the remaining independent claim, claim 15, which recites a method that involves presenting a banner ad *or* the user has a subscription to the website. Auxier and Cottingham do not disclose any way to opt out of receiving a banner ad, much less by having a subscription to the requested website, while Neel enables opt-out by paying a fee for the programming rather than based on a determination that the user already has a subscription to the requested website.

It is respectfully submitted that providing a user with a choice of paying for programming or viewing interactive ads is not the same as, or suggestive of, skipping the step of presenting a banner ad if the user has a subscription to the requested website. To the contrary, since the Neel patent is directed to the "hospitality" industry, which services guests who are using the system on a temporary basis, there is no need in Neel for a pre-existing subscription option, as opposed to a pay-per-view option (at least, the Neel patent does not suggest any such need).

Withdrawal of the rejection under 35 USC §103(a) based on the Auxier, Cottingham, and Neel patents is accordingly requested.

3. Rejection of Claims 7 and 25 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier), 6,339,761 (Cottingham), 5,838,314 (Neel), and 6,286,045 (Griffiths)

This rejection is respectfully traversed on the grounds that the Auxier, Cottingham, and Neel patents fail to disclose or suggest **banner ads** that **block** access to a *user-requested* web

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page unless an appropriate response to the ad is made by the user, *and* in which the banner ads are presented upon diversion of the webpage request to a proxy server *by client software on the user's computing device*, as recited in claims 1 and 21. Instead:

- the Auxier patent teaches **directing users away from the requested website** if a response to an ad is made, which is clearly contrary to the claimed invention; while
- the Cottingham patent discloses targeting of advertisements based on demographic data collected by an ISP, but teaches nothing about using those advertisements to block access to a requested service, much less the claimed use of client software on the user's computing device and/or verification of a subscription to the service;
- the Neel patent teaches the concept of forcing viewers desiring programming to respond to interactive advertisements (see Fig. 7c), but does not suggest using banner ads to provided by a proxy server to which the request for service is diverted by the user's computing device to do so, or that provides for the blocking effect to be avoided in the case of a pre-existing subscription; and
- the Griffiths patent discloses a system for managing "banner ads" by using a proxy server that does not present the ads, but rather than counts of the number of the times the ad has been presented no matter the source of the ads.

Initially, it is respectfully noted that the only reference cited by the Examiner as teaching the claimed proxy server is the Griffith patent. However, while the Griffiths patent mentions proxy servers, the proxy servers are not used to deliver banner ads following diversion by client software on a requester's computing device, as claimed. Instead, according to Griffiths, banner information is initially sent to the user's computing device (or "terminal") after the "desired computer or web site" has been contacted. It is only after the banner information has been downloaded from the desired website that the banner server is contacted to receive the desired banner. There is no "diversion" as claimed, much less control of access to the desired website. **To the contrary, like a conventional banner ad, the banner ad of Griffiths is displayed simultaneously with the requested webpage.** The server that supplies the banner ad does not in any way control access to the requested website, and is not even used if the banner ad is

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already cached or stored on the user's computing device or terminal. Thus, no reasonable combination of the Auxier, Cottingham, Neel and Griffiths patents could possibly have suggested the claimed combination of diversion of an website request to a proxy server that controls access to the requested website, and that does not permit access unless the user responds to a banner ad.

In reply to previous arguments concerning the references, the Examiner points out that:

if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. KSR Int'l Co. V. Teleflex, Inc., . . .

The Applicant does not disagree with this statement. Instead, the Applicant respectfully submits that the present rejection is nothing like the one that was the subject of the KSR case. The KSR case does not represent a license to employ hindsight without regard to how the ordinary artisan would have viewed the applied references. In the KSR case, the prior art included substitution of a known electrical device for a mechanical device, the electrical device carrying out the exact same function as the mechanical device, with completely predictable results. The KSR case did not involve ignoring the actual teachings of the references in favor of an "entirety" not apparent from any of the references, as is the case here, but rather plugging in one device intended for a particular purpose in place of another device intended for that purpose.

In the present instance, the primary reference teaches use of banner ads, as is well-known, to direct a user away from the originally requested website when an appropriate response (clicking on the ad) is made, which is exactly contrary to the claimed direction of a user to the requested website when a particular response is made. While it is true that Neel teaches direction of a user to website, the proposed combination, unlike that discussed in the KSR case, involves wholesale reconstruction of the system of Auxier to carry out a purpose that is the exact opposite of its original purpose, namely to direct users to an advertiser's website, based on teachings in the Neel patent having to do with using advertising revenues to support in-room programming in the hospitality industry. Furthermore, the proxy server of Griffiths is used in a way that is directly contrary to the invention and that has nothing to do with the programming system of

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Neel, namely to supply ads that are displayed together with a requested webpage after the webpage has been accessed.

It is respectfully submitted that the proposed combination of:

- Auxier's teaching of banner ads that direct a user *away* from a requested website when the user responds to the banner ad;
- Cottingham's teaching of targeting banner ads based on ISP collected demographic data;
- Neel's teaching of giving hospitality industry patrons the option of paying for programming or viewing and responding to interactive advertising; and
- Griffiths teaching of obtaining banner ads from an ad server or an internal cache after accessing a website and while displaying the requested webpage,

would not have led the ordinary artisan to conceive of the claimed invention of a proxy server that blocks access to a website unless banner ads are appropriately responded to—even when viewed “in its entirety” (which does not mean “in its entirety while conveniently ignoring actual teachings to make the rejection”).

The Neel patent is clearly the most relevant of the three references applied by the Examiner, since it is the only one that teaches the access blocking effect originally recited in claim 1. However, the context of Neel is such that it would not have been obvious to apply the blocking principle taught therein to the Auxier or Griffiths systems, which have an entirely different purposes than Neel. In the method and system disclosed in the Neel patent, when a guest of a hotel, hospital, or the like wishes to view particular programming, the guest is given the option of paying for the programming or of viewing interactive advertisements to which particular responses are required before the programming can be viewed. However, since the Neel patent is directed to the “hospitality” industry, which services guests who are using the system on a temporary basis, there is no need in Neel for diversion of the type claimed (requests go directly to a systems controller that controls the video server and presents the advertisements).

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Furthermore, it is respectfully submitted that there is no suggestion for the proposed *combination* of Neel, Auxier, Cottingham, and Griffiths. The Neel patent is not directed to increasing response rates to interactive advertisements, as is the case with Auxier and Cottingham, nor does it involve user-entry of a URL or selection of websites, as do Auxier, Cottingham, and Griffiths. The user of Neel is a captive of the institution in which he or she is a guest, and all requests are directed to a central system controlled by or on behalf of the institution rather than being the result of the user inputting a URL.

Still further, it is respectfully noted that the applied references also do not teach the claimed interaction between client software and the proxy server. According to the invention, when the user requests a particular website, the *client software* diverts the user to the proxy server. Griffiths and Auxier also teach an ad server, but the initial URL request by the user is, in both cases, not diverted to a proxy server. Instead, it is transmitted directly to the requested web server, which supplies the banner ad data used in rendering the banner ad. Components of the banner ad may be supplied by the ad server, but it is not the ad server that establishes the connection to the requested website, as claimed. The Java applets referred-to in the Auxier patent do not have the function of the applets of the present invention, but rather are used to provide downloaded ads with an interactive gaming function, while the Griffiths patent does not disclose or suggest any sort of downloaded client or applet. In other words, whereas:

- the claimed "client software" or applets are used to divert a website request to a proxy that controls access to the website,
- the Java applets described in the Auxier patent are downloaded from an ad server in order to enable interaction with the banner ads (see, *e.g.*, col. 5, lines 47), while none of the other references teach any sort of client or applet of the type claimed.

**The claimed use of client software to divert a website request to a proxy ad server is clearly different than Auxier's downloading of applets from an ad server in order to establish an interactive gaming function within an already downloaded ad (completion of the gaming sending the user away from rather than toward the already requested website. The claimed use of client software, in the context of the present invention, is therefore not taught by any of**

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the references of record, including the Auxier, Cottingham, Neel, or Griffiths patents (or the Hamzy patent).

For the above reasons, withdrawal of the rejection of claims 1, 2, 5, 6, 8-15, 19-24, 26-32, 35-39, and 42-49 under 35 USC §103(a) is respectfully requested.

4. Rejection of Claims 16-18, 33, 34, 40, and 41 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier), 6,339,761 (Cottingham), 5,838,314 (Neel), and 6,061,660 (Eggleston)

This rejection has been rendered moot, except with respect to claims 33 and 34, by the incorporation into claims 1 and 21 of the subject matter of claims 7 and 25.

With respect to claims 33 and 34, the rejection is respectfully traversed on the grounds that the Auxier, Cottingham, Neel, and Eggleston patents, whether considered individually or in any reasonable combination, fail to disclose or suggest a method that involves presenting a banner ad or the user has a subscription to the website. Auxier and Cottingham do not disclose any way to opt out of receiving a banner ad, much less by having a subscription to the requested website, while Neel enables opt-out by paying a fee for the programming rather than based on a determination that the user already has a subscription to the requested website, and the Eggleston patent merely discloses an incentive system that provides rewards in the form of credits for viewing advertisements, not by-passing presentation of a banner ad if the user has a subscription to a requested website, much applying the ad-viewing credits to the subscription, as recited in claim 33. In Eggleston, failure to interact with an ad simply means foregoing the opportunity for rewards, and not being blocked from a requested website. Withdrawal of the rejection under 35 USC §103(a) based on the Auxier, Cottingham, Neel, and Eggleston patents is accordingly respectfully requested.

Having thus overcome each of the rejections made in the Official Action, and in addition having sought to overcome the potential rejection based on the Hamzy patent by amending the

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claims to distinguish the Hamzy patent, withdrawal of all rejections and expedited passage of the application to issue is requested.

Should the Examiner feel that amendments to the claims would place the application in better condition for allowance, the Examiner is invited to contact the undersigned at any time to discuss such amendments.

Respectfully submitted,

**BACON & THOMAS, PLLC**

*[Signature]*

By: BENJAMIN E. URCLA  
Registration No. 33,805

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**BACON & THOMAS, PLLC**  
625 Slaters Lane, 4th Floor  
Alexandria, Virginia 22314

Telephone: (703) 683-0500

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